



06 MAY 2003

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In re Application of :
WALLACE, Andrew :
Application No.: 09/719,362 :
PCT No.: PCT/GB99/01691 : DECISION ON PETITION
Int. Filing Date: 14 June 1999 : UNDER 37 CFR 1.181
Priority Date: 12 June 1998 :
Atty. Docket No.: 7397-2 :
For: METHOD OF GENERATING :
NUCLEIC ACID HYBRIDS FOR :
MUTATION ANALYSIS :

This is a decision on applicant's unsigned communication dated 25 July 2002, "Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.181," and "Second Submission of Sequence Listing in Paper and Computer Readable Form" filed 22 November 2002.

BACKGROUND

On 14 June 1999, applicant filed international application no. PCT/GB99/01691 which claimed a priority date of 12 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 December 1999. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 12 December 2000.

On 11 December 2000, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 01 February 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not in compliance with 37 CFR 1.66 or 37 CFR 1.68, and that a new oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. The notification set a ONE (1) MONTH period for response.

On 07 May 2001, applicant filed a declaration and power of attorney.

On 22 May 2001, the United States Designated/Elected Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not in compliance with 37 CFR 1.497(a) and (b), and that a new oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Specifically, the declaration was not in compliance with 37 CFR 1.497(a) and (b) because it did not identify the city and state and foreign country of residence for the inventor.

On 25 June 2001, applicant filed a declaration and power of attorney.

On 11 July 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence And/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/920) indicating that applicant had not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).

On 01 July 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 11 July 2001 within the time period set therein.

On 22 November 2002, applicant filed "Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.181," and "Second Submission of Sequence Listing in Paper and Computer Readable Form."

DISCUSSION

A. Petition to Withdraw Holding of Abandonment

The above-identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 11 July 2001, in that, the sequence listing and sequence listing in computer readable form had not been submitted within the period set therein. Applicant states in their present petition that a Sequence Listing in Paper and Computer Readable Form were submitted to the Patent and Trademark Office on 15 September 2001. A review of the present application reveals that the Submission of Sequence Listing in Paper and Computer Readable Form in Response to the Second Notice of Missing Requirements filed 15 September 2001 is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the

PTO of all the items listed thereon on the date stamped thereon by the PTO."

The best evidence of what was actually received by the Office on a particular date is a copy of returned date stamped postcard receipt that was filed with papers in question and contains a specific itemization of all items being submitted. In the present instance, applicant has provided a postcard receipts which shows the "Subm. of Seq. Listing/Response to 2nd Not. of Missing Parts" being filed. The receipt is stamped "Rec'd. PCT/PTO 15 SEP 2001." The postcard receipt bearing the applicants name, title of invention, and attorney docket number is sufficient to indicate that the above papers were received on 15 September 2001. Therefore, applicant's petition to withdraw holding of abandonment is granted.

B. Raw Sequence Listing

The present petition was accompanied by "Second Submission of Sequence Listing in Paper and Computer Readable Form." A review of the Raw Sequence Listing by the Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) reveals that the nucleotide and/or amino acid sequence disclosure contained in the application does not comply with the requirement for such a disclosure as set forth in 37 CFR 1.821 -1.825. (See attached copy of Raw Sequence Error Report.)

CONCLUSION

The petition to withdraw holding of abandonment is **GRANTED** and the holding of abandonment has been withdrawn.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Defective Response (Form PCT/DO/EO/916) and a Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence And/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/920) indicating that applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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